

FAY, SHARPE, BEALL, FAGAN, MINNICH & MCKEE
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(216) 861-5582

DATE: October 23, 1998
TO: U.S. Patent and Trademark Office
ATTENTION: Examiner Harold Joyce -- Art Unit 3744
FACSIMILE NO.: 1-703-305-3463
FROM: Joseph D. Dreher
RE: Our Ref. Nos.: TRW 2 136-4

Total number of pages (including this cover sheet): 18

Please call us immediately at (216) 861-5582 if the telecopy you receive is incomplete or illegible. Our facsimile numbers are (216) 241-1666 and (216) 241-5147.

Re: Serial No. 08/230,083, Filed: April 20, 1994
Our Reference: TRW 2 136-4

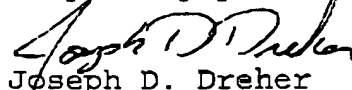
Dear Examiner Joyce:

As requested, attached are copies of the following:

- 1.) April 9, 1998 Office Action;
- 2.) August 10, 1998 Response (with transmittal, attachments, and extension request); and,
- 3.) Postcard for the August Response

Once you've had an opportunity to review these documents, please call.

Very truly yours,


Joseph D. Dreher

JDD/kan
Attachments

The documents accompanying this facsimile transmission include information from the firm of Fay, Sharpe, Beall, Fagan, Minnich & McKee that might be legally privileged and/or confidential. The information is intended for the use of only the individual or entity named on this cover sheet. If you are not the intended recipient, any disclosure, copying, or distribution of these documents, or the taking of any action based on the contents of this transmission, is prohibited. If you have received this transmission in error, these documents should be returned to this firm as soon as possible, and we ask that you notify us immediately by telephone so we can arrange for their return to us without cost to you.

COPY**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
087230,083	04/20/94	KRAUS	TRW21364

FAY, SHARPE, BEALL, FAGAN,
MINNICH & MCKEE
1100 SUPERIOR AVE., STE 700
CLEVELAND OH 44114-2518

QM6170409

EXAMINER

JOYCE, H

ART UNIT

PAPER NUMBER

3744

RECEIVED**APR 13 1998**

DATE MAILED: 04/09/98

FAY, SHARPE, BEALL, FAGAN,
MINNICH & MCKEE**Please find below and/or attached an Office communication concerning this application or proceeding.**

Commissioner of Patents and Trademarks

"DOCKETED"

COPY**Office Action Summary**

Application No.

08/230,083

Applicant(s)

Willibald Kraus

Examiner

H. Joyce

Group Art Unit

3404

☒ Responsive to communication(s) filed on Jul 12, 1996☐ This action is **FINAL**.☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three (3) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims☒ Claim(s) 1-14 and 16 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 1-14 is/are allowed.☒ Claim(s) 16 is/are rejected.☐ Claim(s) _____ is/are objected to.☐ Claims _____ are subject to restriction or election requirement.**Application Papers**☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on _____ is/are objected to by the Examiner.☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.☐ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119**☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)**☐ Notice of References Cited, PTO-892☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____☐ Interview Summary, PTO-413☐ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Serial Number: 08/230,083
Art Unit: 3404

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Page 2

DETAILED ACTION

Recapture Issues and Rejection

1. During the prosecution of S.N. 07/642,475, which matured into U.S. Patent No. 5,105,731 claims 1, 3-5 and 7-11 were rejected under 35 USC 103 as being unpatentable over either Feles et al. or Frien in view of Mizusawa, but claims 2 and 12-14 were only objected to were indicated to be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claim.

In response to that rejection, applicant filed an amendment in which claims 2 and 12 were canceled and were rewritten in independent form and the statement was made that "the claims as now presented were patentable over all of the prior art of record."

Thus, the prosecution history of U.S. Patent No. 5,105,731 clearly reveals that applicant surrendered a claim having the scope of claim 1 in an attempt to obtain allowance of the original patent claims. In particular, applicant added the limitations contained in originally presented claim 2 to obtain allowance of his application.

The specific limitations which were added to claim 1 to obtain an allowable claim were:

wherein the inner frame (4) has a surrounding rim (7) carrying rib members (8) spaced transversely with stays (9) extending therefrom and a surrounding frame (1) joining the stays (9).

In this reissue application, applicant has presented claims 14-16, none of which recites the limitations added to obtain allowance of the patent.

Serial Number: 08/230,083
Art Unit: 3404

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Page 3

Each of these claims must be addressed to determine if it violates the recapture doctrine.

Claim 14's scope differs from that of originally filed claim 1 by specifying that there are two clip connections, one of which comprises a springy tongue and is spaced from the surrounding wall, and the other of which comprises a springy tongue which is integral with the surrounding wall. Thus, its scope is narrower than originally filed claim 1. It does not appear to be broader in any aspect than claim 1. Therefore, it does not violate the recapture rule. In this regard, see In re Clement, 45 USPQ2d 1161, 1165 (Fed. Cir. 1997).

Claim 15, which properly depends from claim 14, also has a scope which does not appear to be broader in any respect than originally filed claim 1. Therefore, it does not violate the recapture doctrine.

However, claim 16 adds no limitations to what was recited in originally filed claim 1 and, thus, clearly violates the recapture doctrine.

Claims 16 is rejected under the equitable "recapture" doctrine which prevents a reissue applicant from obtaining subject matter surrendered in an attempt to obtain allowance of the original patent claims. See, in this regard, In re Clement, 45 USPQ2d 1161, 1164 (Fed. Cir. 1997).


2. This reissue application was filed without the required offer to surrender the original patent or, if the original is lost or inaccessible, an affidavit or declaration to that effect. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Serial Number: 08/230,083
Art Unit: 3404

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Page 4

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to H. Joyce whose telephone number is 703/308/0274 and whose Group fax number is 703/305/3463.


HAROLD JOYCE
PRIMARY EXAMINER
ART UNIT 3404

HJ
March 17, 1998

AMENDMENT TRANSMITTAL LETTER

Attorney Docket No.: TRW 2 136-4

Serial No: 08/230,083	Filing Date: April 20, 1994	Examiner: H. Joyce
Group Art Unit: 3744	Invention: BLOCKING OF RETURN AIR	

Assistant Commissioner for Patents
Washington, D.C. 20231

COPY

Transmitted herewith is a Response and Request for a One-Month Extension of Time in the above-identified application. The fee has been calculated as shown below.

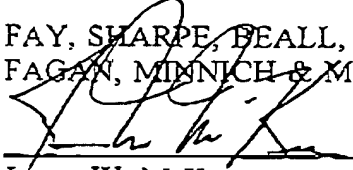
CLAIMS AS AMENDED						
	Claims remaining after amendment		Highest Number Previously Paid For	No. of Extra Claims Present	Rate	Additional Rate
Total Claims	15	Minus	20	-0-	x \$22.00	\$ - 0 -
Indep. Claims	5	Minus	5	-0-	x \$82.00	\$ - 0 -
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ - 0 -

- _____ No additional fee is required.
- _____ A check in the amount of \$_____ to cover the additional fee is enclosed.
- X A check in the amount of \$110.00 (Large Entity Fee) is attached for a one-month extension of time.
- X Please charge any additional fees or credit overpayment to Deposit Account No. 06-0308.
- X Applicant(s) hereby request(s) any additional extensions of time that may be necessary and authorize the extension of time fees to be charged to Deposit Account No. 06-0308.

Date: August 10, 1998

Respectfully submitted,

FAY, SHARPE, BEALL,
FAGAN, MINNICH & MCKEE


James W. McKee
Reg. No. 26,482
1100 Superior Avenue, 7th Floor
Cleveland, Ohio 44114-2518
(216) 861-5582

CERTIFICATE OF MAILING

I hereby certify that this Response and Request for a One-Month Extension of Time is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on August 10, 1998.

By 
Dottie M. Freeland

Duplicate #22

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF : Willibald Kraus
FOR : BLOCKING OF RETURN AIR
SERIAL NO. : 08/230,083
FILED : April 20, 1994
ART UNIT : 3744
EXAMINER: : H. Joyce
LAST OFFICE ACTION : April 9, 1998
ATTORNEY DOCKET NO. : TRW 2 136-4

Cleveland, Ohio 44114-2518
August 10, 1998

RESPONSE

Assistant Commissioner for Patents
Washington, D. C. 20231

Dear Sir:

Responsive to the Examiner's Action mailed April 9, 1998 in connection with the above-referenced U.S. patent reissue application, the applicant respectfully requests reconsideration of the application.

Claims 1-14 and 16 are pending. The Examiner's indication of allowability of claims 1-14 is acknowledged and appreciated. However, claim 16 stands rejected.

More particularly, the Examiner rejected claim 16 under the equitable "recapture" doctrine. It is his position that claim 16 adds no limitation to what was recited in originally filed claim 1 and, thus, violates this doctrine.

It is respectfully submitted, however, that claim 16 does indeed add limitations to that which was recited in application claim 1 and, therefore, does not violate the recapture doctrine. More specifically, application claim 1 recited the following:

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1. In a check valve assembly in association with the ventilation system for the passenger space of a motor vehicle, said assembly comprising an outer housing to which an inner frame is connected with a check valve element formed of flexible sheet material clamped between the outer housing and the inner frame, the improvement wherein the inner frame (4) is received into an open end of the outer housing (3) and the assembled unit comprising the inner frame (4), the outer housing (3), and the check valve (3) is joined to a support (2) of the motor vehicle through a resilient clip connection (6) carried on the outer housing (3).

Reissue application claim 16 reads as follows:

16. A check valve assembly adaptable for use with a ventilation system of a passenger space of a motor vehicle, the assembly comprising:
an outer housing having an open end;
an inner frame received in the open end;
a check valve element formed of flexible sheet material clamped between the outer housing and the inner frame; and,
a resilient clip connection formed separate from the outer housing and carried on a locking element which is connected with the outer housing, the clip connection securing the outer housing to the locking element and joining the inner frame, the outer housing, and the check valve element to the motor vehicle.

The applicant previously indicated a relationship between original application claim 1 and reissue claim 16, i.e., that claim 16 was being pursued because claim 1 was previously canceled. However, notwithstanding this, claim 16 recites additional limitations not present in claim 1. For example, claim 16 recites that the resilient clip connection is separate from the outer housing and carried on a locking element which is connected with the outer housing. Moreover, the claim states that the clip connection secures the outer housing to the locking

COPY

element. Accordingly, it is respectfully submitted that reissue claim 16 does not violate the recapture doctrine and is in condition for allowance.

The Examiner further notes that proper surrender of the original patent has not been made. However, a Notice of Surrender of Original Patent was made to the United States Patent and Trademark Office on January 26, 1998. A copy of that Notice, as well as the postcard received from the U.S.P.T.O., are attached for the convenience of the Examiner.

In view of the foregoing, all objections are submitted to be overcome. As such, all claims are now in condition for allowance. Early notification of such allowance is hereby respectfully requested.

Respectfully submitted,

FAY, SHARPE, BEALL, FAGAN,
MINNICH & McKEE



James W. McKee

Reg. No. 26,482

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CERTIFICATE OF MAILING

I hereby certify that this Response for U.S. Patent Application No. 08/230,083 is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner For Patents, Washington, D.C. 20231, on August 10, 1998.


Dottie M. Freeland

COPY

Inventor/Applicant: <u>Willibald Kraus</u>		Pat. No. <u>5,105,731</u>
Title: <u>Blocking of Return Air</u>		Ser. No. <u>08/230,083</u>
Attorney Docket No. <u>TRU 2136-4</u>	Initials <u>TRU/DGB/JDD</u>	Filed <u>4/20/94</u>
		Date <u>11/26/98</u>

<input type="checkbox"/> PATENT/DESIGN APPLICATION	<input type="checkbox"/> AMENDMENT (Due <u>not</u>)
<u> </u> New Application Transmittal	<u> </u> Transmittal(s)
<u> </u> Cont. <u> </u> Div. <u> </u> C-I-P	<u> </u> Extension of Time (For <u> </u> month(s))
<u> </u> Declaration/Power of Atty.	
<u> </u> pgs. Specification	<input checked="" type="checkbox"/> OTHER <u>Notice of</u>
<u> </u> pgs. Claims	<u>Surrender of</u>
<u> </u> total <u> </u> independent	<u>Original Patent</u>
<u> </u> pgs. Abstract	<u>and</u>
<u> </u> Sheet(s) of drawing(s)	<u>Original Patent</u>
<u> </u> formal <u> </u> informal	
<u> </u> Preliminary Amendment	
<u> </u> Claim for Right of Priority	
<u> </u> Priority document(s)	
<u> </u> Small Entity Statement	
<u> </u> Final Fee	
<u> </u> Response to missing parts	
<input type="checkbox"/> ASSIGNMENT	
<u> </u> Transmittal <u> </u> Confirmatory	
<input type="checkbox"/> INFORMATION DISCLOSURE STATEMENT	
<u> </u> PTO Form 1449 <u> </u> Refs.	
<input type="checkbox"/> CHECK(S) In Amount \$ <u> </u>	

RECEIPT IS HEREBY ACKNOWLEDGED

86/98



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"Express Mail" Mailing Label Number EM098342470US
Date of Deposit: January 26, 1998
I hereby certify that this paper or fee is
being deposited with the United States
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the date indicated above and is addressed to the
Assistant Commissioner of Patents
Washington, D.C. 20231-9999

Dottie M. Freeland
DOTTIE M. FREELAND

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE REISSUE APPLICATION OF : Willibald Kraus
FOR : BLOCKING OF RETURN AIR
SERIAL NO. : 08/230,083
FILED : April 20, 1994
EXAMINER : H. Joyce
ART UNIT : 3404
ATTORNEY DOCKET NO. : TRW 2 136-4

Cleveland, Ohio 44114-2518
January 26, 1998

NOTICE OF SURRENDER OF ORIGINAL PATENT

Assistant Commissioner for Patents
Washington, DC 20231

Dear Sir:

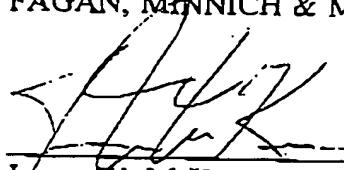
Pursuant to 37 C.F.R. 1.178 and as requested by the Examiner, the applicant hereby surrenders the original U.S. Patent No. 5,105,731 to Kraus (enclosed herewith) in favor of the above referenced reissue application (Serial No. 08/230,083) for which the issue fee was paid on February 5, 1997.

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In view of the foregoing, the applicant respectfully submits that the reissue application is now in condition for issuance. Prompt favorable action is hereby respectfully requested.

Respectfully submitted,

FAY, SHARPE, BEALL,
FAGAN, MINNICH & MCKEE



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COPY
*The
United
States
of
America*

The Commissioner of Patents
and Trademarks

*Has received an application for a patent
for a new and useful invention. The title
and description of the invention are en-
closed. The requirements of law have
been complied with, and it has been de-
termined that a patent on the invention
shall be granted under the law.*

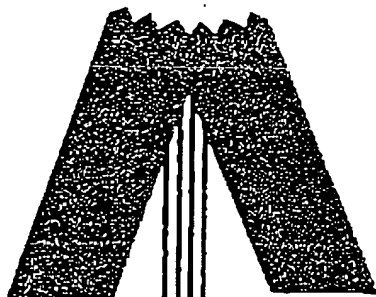
Therefore, this

United States Patent

*Grants to the person or persons having
title to this patent the right to exclude
others from making, using or selling the
invention throughout the United States
of America for the term of seventeen
years from the date of this patent, sub-
ject to the payment of maintenance fees
as provided by law.*

Harry F. Markush, Jr.

Commissioner of Patents and Trademarks


Matthew G. Thompson
Attest

COPY

United States Patent (19)

Kraus

[11] Patent Number: 5,105,731

[45] Date of Patent: Apr. 21, 1992

[54] BLOCKING OF RETURN AIR

[55] Inventor: Willibald Kraus, Grunstadt, Fed.
Rep. of Germany[57] Assignee: TRW United-Carr GmbH & Co.,
K.G., Enkenbach-Alsenborn, Fed.
Rep. of Germany

[21] Appl. No.: 642,475

[22] Filed: Jan. 17, 1991

[30] Foreign Application Priority Data

Jan. 24, 1990 [DE] Fed. Rep. of Germany 4002052

[51] Int. Cl.⁵ B60H 1/26

[52] U.S. Cl. 454/143; 454/259

[58] Field of Search 98/2, 2-18

[56] References Cited

U.S. PATENT DOCUMENTS

3,405,968 10/1968 Fetes et al. 98/2.18

4,691,623 9/1987 Mizusawa 98/2.18

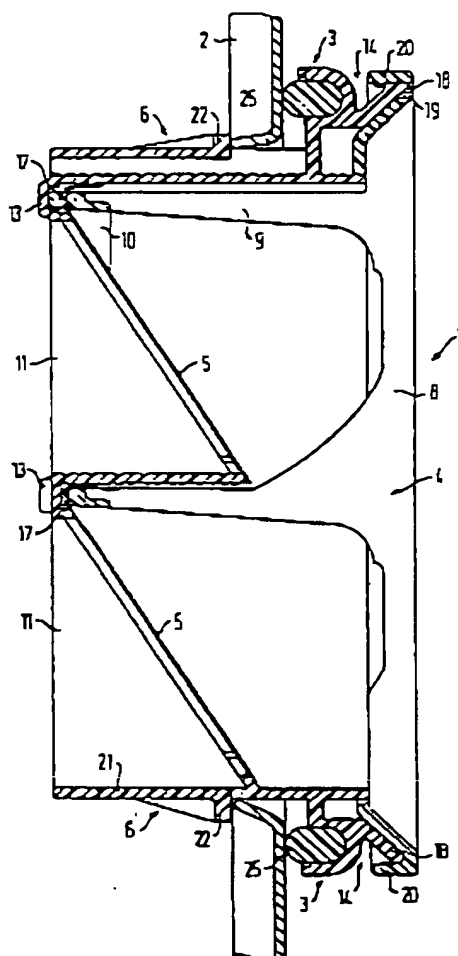
4,781,106 11/1988 Frien 98/2.18

Primary Examiner—Harold Joyce
Attorney, Agent, or Firm—Fay, Sharpe, Beall, Fagan,
Minnich & McKee

[57] ABSTRACT

A check valve assembly for the ventilation duct to the passenger space of a motor vehicle comprises an outer housing (3), to which is fastened through at least one clamping connection an inner frame (4). Between the outer housing (3) and inner frame (4) there is clamped at least one check valve element (5) of flexible, soft sheet material. In the rest position, the valve element lies against an oblique grating (11). When air flows, the valve element opens and engages against stays (9). The inner frame (4) is set into the front of the outer housing (3) and the assembled unit comprised of outer housing (3) and closing valve (5) is fastened to a support (2) of the motor vehicle by at least one clip connection (6) arranged on the outer housing (3).

13 Claims, 3 Drawing Sheets



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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE REISSUE APPLICATION : Willibald Kraus
FOR : BLOCKING OF RETURN AIR
SERIAL NO. : 08/230,083
FILED : April 20, 1994
ART UNIT : 3744
EXAMINER: : H. Joyce
LAST OFFICE ACTION : April 9, 1998
ATTORNEY DOCKET NO. : TRW 2 136-4

Cleveland, Ohio 44114-2518
August 10, 1998

REQUEST FOR A ONE-MONTH EXTENSION OF TIME

Assistant Commissioner for Patents
Washington, DC 20231

Dear Sir:

The initial period for response to the outstanding Office Action, issued April 9, 1998, expired on July 9, 1998.

Pursuant to 37 C.F.R. § 1.136, applicant hereby petitions for a one-month extension of time up to and including August 10, 1998 (August 9 was a Sunday) in which to respond to the Office Action. A check in the amount of \$110.00 for the extension fee is enclosed herewith.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Deposit Account No. 06-0308.

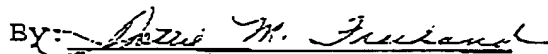
COPY

Respectfully submitted,

FAY, SHARPE, BEALL,
FAGAN, MINNICH & MCKEE

James W. McKee
Reg. No. 26,482
1100 Superior Avenue
Seventh Floor
Cleveland, OH 44114-2518
(216) 861-5582CERTIFICATE OF MAILING

I hereby certify that this REQUEST FOR A ONE-MONTH EXTENSION OF TIME is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, DC 20231, on August 10, 1998.

By: 
Dottie M. Freeland

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NO. 107

Inventor: Willibald Kraus Pat. No. _____
Title: Blocking of Return air Ser. No. 08/230,083
Attorney Docket No. OTRW 5136-4 Initials JWM DGB/JDD/any Filed 4/20/98
Date 8/10/98

☐ PATENT/DESIGN APPLICATION
New Application Transmittal
Cont. Div. CIP
Declaration/Power of Atty.
pgs. Specification
pgs. Claims
total independent
pgs. Abstract
Sheet(s) of drawing(s)
formal informal
Preliminary Amendment
Claim for Right of Priority
Priority document(s)
Small Entity Statement
Final Fee
Response to missing parts

☒ RESPONSE TO AMENDMENT (Due August 10, 1998)
Transmittal(s)
Extension of Time (For 1 month(s))
OTHER _____

RECEIPT IS HEREBY ACKNOWLEDGED

☐ ASSIGNMENT
Transmittal Confirmatory
☐ INFORMATION DISCLOSURE STATEMENT
PTO Form 1449
☒ CHECKED in Amount of \$ 110.00

U.S. PATENT & TRADEMARK OFFICE
AUG 12 1998